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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,058	11/10/2000	David Anderson	A-68531-1/RMS/JJD/SPL	4112

24353 7590 10/09/2003

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EXAMINER

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 10/09/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

210 copy

Advisory Action

Application No.

09/710,058

Applicant(s)

ANDERSON ET AL.

Examiner

Bennett Celsa

Art Unit

1639

--Th MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached continuation of Advisory.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-9 and 14-19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Bennett Celsa
Primary Examiner
Art Unit: 1639

ADVISORY ACTION CONT.

Reasons for Nonentry of after-final amendment. :

1. introduce additional consideration.
2. necessitate additional search including update search.
3. may necessitate the modification of outstanding rejection (s) to address the new claim limitations and/or necessitate the raising of new grounds of rejection.
4. no reason why amendment was not earlier presented.
5. does not simplify issues for appeal .
6. does not place the case in immediate condition for allowance.

*Brief Comments regarding the rejections of record and applicant's
amendment/argument relating thereto in order to aid in the further prosecution of the
present application*

a. Written description would appear not to be overcome:
applicant' s claim still encompasses a polynucleotide which reads on a gene (with introns) which applicant lacks possession of. Amending to positively recite cDNA will overcome this rejection. Applicant's arguments directed to cDNA is not commensurate to claimed invention.

- It is noted that applicant's claim are polynucleotide claims and applicant's arguments (and citing of guidelines) directed to proteins (or analogs) is not on point.

b. Anticipation rejection (claims 1-9) over the Aran et al. reference would appear to be overcome by proposed after-final amendment.

c. Anticipation rejection (claims 4-6) over the Abedi et al. reference would appear to be overcome by proposed after-final amendment.

d. Anticipation rejection (claims 1-9) over the Anderson et al. reference would appear to be overcome by proposed after-final amendment.

e. Anticipation/Obviousness rejections over the Bryan '107 patent reference and obviousness rejection over Aryan and Bryan '107 do not appear to be overcome by proposed after-final amendment. Applicant's arguments fail to address the claimed invention (e.g. drawn to polynucleotide not protein) nor rebut the teaching of the reference's polynucleotide's sequence (with greater than 95% to elected nucleotide sequence) ability to encode a polypeptide with greater than 95% homology to seq. 2 or 5 polypeptide.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 703-305-7556. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

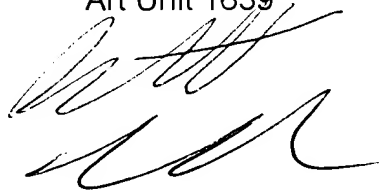
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Bennett Celsa
Primary Examiner
Art Unit 1639

BC
October 7, 2003

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.